

### REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1, 3, 4, 6-11, 13, 14, 16-21, 23, 24, and 26-39 are currently pending. No claims have been amended herewith.

In the outstanding Office Action, Claims 1, 3-4, 6-8, 11, 13, 14, 16-18, 21, 23, 24, 26-28, and 31-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,887,216 to Motoyama (hereinafter "the '216 patent") in view of U.S. Patent No. 6,584,454 to Hummel, Jr. et al. (hereinafter "the '454 patent"); and Claims 9, 10, 19, 20, 29, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '216 and '454 patents, further in view of U.S. Patent No. 6,167,358 to Othmer et al. (hereinafter "the '358 patent").

Applicants wish to thank the Examiner for the interview granted Applicants' representative on May 18, 2005, at which time the outstanding rejection of Claim 1 was discussed. In particular, the claimed service history was discussed. At the conclusion of the interview, the Examiner agreed to reconsider the outstanding rejection in light of the discussion, upon formal submission of a response to the outstanding Office Action.

Claim 1 is directed to a system for tracking at least one of a device state and a device event of a remotely monitored device, comprising: (1) a receiver configured to receive the at least one of the device state and the device event of the remotely monitored device; (2) a digital storage system configured to maintain a history of the at least one of the device state and the device event of the remotely monitored device and a service history of the remotely monitored device; (3) an analyzer configured to analyze the service history and the at least one of the device state and the device event of the remotely monitored device to determine a service request to be performed on the remotely monitored device; and (4) a service depot

comprising a computer configured to receive the service request from the analyzer over a Wide Area Network, to analyze the service request, and to contact a user of the remotely monitored device regarding the service request. Further, Claim 1 recites that the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103, the Office Action asserts that the '216 patent discloses everything in Claim 1 with the exception of a service depot configured to receive the service request, to analyze the service request, and to contact a user of the remotely monitored device regarding the service request, and relies on the '454 patent to remedy that deficiency.

The '216 patent is directed to a method and system for determining whether problems exist in a business office device by analyzing user settings of the business office device. However, as admitted in the Office Action, the '216 patent fails to disclose a service depot comprising a computer configured to receive a service request from an analyzer over a Wide Area Network and to analyze the service request, as recited in Claim 1. Further, Applicants respectfully submit that the '216 patent fails to disclose an analyzer configured to analyze the service history and the at least one of the device state and the device event of a remotely monitored device to determine a service request to be performed on the remotely monitored device, as recited in Claim 1. Rather, as shown in Figure 8, the '216 patent merely discloses communication between a monitoring device and a monitored device in which the monitoring device requests and receives image density information from the monitored device and, based on the received information, requests a change in a parameter in the monitored device. However, the '216 patent fails to disclose that the monitoring device is configured to analyze the service history of the remotely monitored device. Rather, the '216 patent merely discloses that "the monitoring device analyzes the received information (i.e., compares the

received information with information looked up in the database) and determines that it is appropriate to change parameters of the monitored device.”<sup>2</sup> Applicants respectfully submit that a disclosure of analyzing image density information received from a monitored machine and “information” looked up in a database is not equivalent to a disclosure of analyzing the service history of the machine. In this regard, Applicants note that Figure 9C of the ‘216 patent is directed to the database storing the history of the machine and includes an ID field, a date/time field, and an information field and is used to describe malfunctions or other special conditions and events within the machine including the date and time at which the event occurred. However, the passage cited in the Office Action does not refer to Figure 9C.

The ‘454 patent is directed to a method and system for delivery of protected software applications to remote systems from a central service facility, wherein the delivery is managed based on the community membership of a remote system user. As shown in Figure 1, the ‘454 patent discloses a central service facility 22, a management station 70, and medical diagnostic systems 12. Applicants note that page 3 of the Office Action asserts that the ‘454 patent discloses that the central service facility 22 is configured to receive a service request from the management station 70 to analyze the service request, and to contact the user of the remotely monitored device. However, Applicants note that the management station 70 is not an analyzer configured to analyze the service history of a remotely monitored device, but simply forwards service requests generated by users of the diagnostic systems 12. Rather, the ‘454 patent discloses that the service histories of the machines are stored in database 88, which is associated with the central service facility 22.<sup>3</sup>

Thus, no matter how the teachings of the ‘216 and ‘454 patents are combined, the combinations do not teach or suggest an analyzer configured to analyze a service history and at least one of the device state and device event of the remote of a remotely monitored device

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<sup>2</sup> The ‘216 patent, column 10, lines 13-18.

<sup>3</sup> See ‘454 patent, column 6, lines 13-37.

to determine a service request to be performed on the remotely monitored device, as recited in Claim 1. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 1 (and dependent Claims 3, 4, 6-8 and 31) should be withdrawn.

In the outstanding Office Action, the stated motivation for combining the teachings of the '216 and '454 patents is "because it would allow the service depot efficiently to schedule service engineers to address the service request and provide off- and on-line service to the remote device in response to the service request."<sup>4</sup> However, Applicants note that the '454 patent does not disclose that the service facility 22 allows for efficient scheduling of service engineers, only that the service facility 22 has a bank of operator workstations 86. Thus, the Office Action is simply making a conclusive statement regarding the central service station and is not relying on any factual evidence of record as motivation to combine the cited references. Moreover, Applicants submit that there is no technological motivation to combine the teachings of the '216 and '454 patents. In the '454 system, the service requests originate with the users of the diagnostic machines and are sent to the central service facility 22 via the management station 70. In contrast, in the '216 system, the service requests originate with the monitoring device, which communicates directly with the monitored device. Thus, it is unclear how a combined system in which the '454 management station is replaced by the '216 monitoring device would work since the '216 monitoring device is not configured to send out service requests to a service depot or to simply forward service requests generated by a diagnostic machine. Accordingly, for the reasons stated above, Applicants respectfully submit that the Office Action has failed to provide motivation for one of ordinary skill in the art to combine the teachings of the '216 and '454 patents in the manner suggested in the Office Action.

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<sup>4</sup> See page 4 of the Office Action dated April 1, 2005.

Independent Claims 11 and 21 recite limitations analogous to limitations recited in Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claims 11 and 21 (and all similarly rejected dependent claims) should be withdrawn.

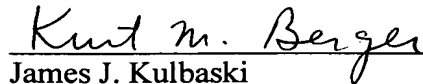
Regarding the rejection of dependent Claims 9, 10, 19, 20, 29, and 30 under 35 U.S.C. § 103, Applicants respectfully submit that the '358 patent fails to remedy the deficiencies of the '216 and '454 patents, as discussed above. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejections of dependent Claims 9, 10, 19, 20, 29, and 30 should be withdrawn.

Thus, it is respectfully submitted that independent Claims 1, 11, and 21 (and all associated dependent claims) patentably define over any proper combination of the '216, '454, and '358 patents.

Consequently, in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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